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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,893	03/29/2001	Yasushi Kawakura	204411US-2 RD	5382

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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JOHNSON, GREGORY L

ART UNIT	PAPER NUMBER
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3691

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/04/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/04/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/819,893	<b>Applicant(s)</b> KAWAKURA ET AL.	
	<b>Examiner</b> GREGORY JOHNSON	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7,9,11-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,9,11-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/05/2006 and 03/29/01</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL filed November 13, 2006. Claims 1, 2, 4, 5, 7, 9, 11-16 and 18-21 have been examined.

### ***Priority***

2. Applicant is granted foreign priority filing date of March 31, 2000.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 5, 13-16, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rackson et al. (herein Rackson), US Pat. No. 6,415,270 B1.

As to claim 1, Rackson discloses a server computer (col. 8, lines 6-17 and 49-63) for electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said server computer connected through a network to a plurality of terminals, each associated with

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a bidder in the auction for the exhibited item of merchandise (col. 8, lines 49-63), said server computer comprising:

a merchandise database storing configured to store a plurality of merchandise information (col. 9, lines 1-49);

means for selecting the alternative merchandise information from said merchandise database based on provided bid information of an unsuccessful bidder in the auction for the exhibited item of merchandise the alternative merchandise information being information concerning an unexhibited item of merchandise that was not exhibited in the auction and the unsuccessful bidder being a bidder in the auction who did not win the exhibited item (col. 23, lines 18-29); and

means for causing to notify a terminal associated with the unsuccessful bidder of the selected alternative merchandise concerning the unexhibited item of merchandise (col. 23, lines 19-29).

As to claim 2, Rackson discloses the server computer of claim 1, further comprising:

means for extracting preference information based on bid information of a bidder and exhibited merchandise information bid on by the bidder (col. 14, lines 7-49); and

means for selecting alternative merchandise information based on the preference information (col. 23, lines 18-29).

As to claim 4, Rackson discloses a server computer (col. 8, lines 6-17 and 49-63) for electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said server computer connected through a network to a plurality of terminals each associated with a bidder in the auction for the exhibited item of merchandise (col. 8, lines 49-63), said server computer comprising:

an auction execution unit configured to hold the electronic auction, said auction execution unit comprising, a providing module configured to provide information regarding the exhibited item of merchandise for the auction to the terminals, and a receiving module configured to receive bid information, which includes bid information indicating a bidder from the terminals and configured to store the bid information (col. 8, lines 49-67 and col. 9, lines 1-49);

a merchandise database configured to store a plurality of merchandise information (col. 9, lines 1-49);

means for selecting the alternative merchandise information from the merchandise database based on the stored bid information of an unsuccessful bidder in the auction for the exhibited item of merchandise the alternative merchandise information being information concerning an unexhibited item of merchandise that was not exhibited in the auction, and the unsuccessful bidder being a bidder who did not win the exhibited item in the auction (col. 23, lines 18-29); and

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means for causing to notify a terminal associated with the unsuccessful bidder of the selected alternative merchandise information concerning the unexhibited item of merchandise (col. 23, lines 19-29).

As to claim 5, Rackson discloses the server computer of claim 4, said further comprising:

means for extracting preference information based on the stored bid information of a bidder and the exhibited merchandise information bid on by the bidder (col. 14, lines 7-49); and

means for selecting the alternative merchandise information based on the preference information (col. 23, lines 18-29).

As to claim 13, Rackson discloses a method (col. 8, lines 6-17 and 49-63) of electronically introducing alternative merchandise information to an unsuccessful bidder in an electronic auction for an exhibited item of merchandise after closing the electronic auction (col. 23, lines 18-29), in a system including a server computer connected through a network to a plurality of terminals each associated with a bidder in the auction for an exhibited item of merchandise (col. 8, lines 49-63), said method comprising: selecting the alternative merchandise information from a plurality of merchandise information based on bid information of the unsuccessful bidder, the alternative merchandise information being information concerning an unexhibited item of merchandise not exhibited in the auction (col. 23, lines 18-29); and

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causing to transmit the selected alternative merchandise information regarding the unexhibited merchandise to a terminal associated with the unsuccessful bidder (col. 23, lines 19-29).

As to claim 14, Rackson discloses the method of claim 13, wherein said selecting step comprises:

extracting preference information based on the bid information and exhibited merchandise information bid on by the unsuccessful bidder (col. 14, lines 7-49); and selecting the alternative merchandise information from the plurality of merchandise information based on the preference information (col. 23, lines 18-29).

As to claim 15, Rackson discloses a method (col. 8, lines 6-17 and 49-63) of electronically introducing alternative merchandise information after closing an electronic auction for an exhibited item of merchandise (col. 23, lines 18-29), said method comprising:

providing exhibited merchandise information for the auction to terminals of participants, receiving bid information, which includes information indicating each participant from the terminals (col. 8, lines 49-67 and col. 9, lines 1-49);

storing the bid information (col. 9, lines 1-49);

selecting the alternative merchandise information from a plurality of merchandise information based on the stored bid information, the alternative merchandise information

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concerning an unexhibited merchandise not exhibited in the auction (col. 23, lines 18-29); and

causing to transmit the alternative selected merchandise information concerning the unexhibited merchandise to a terminal of an unsuccessful participant who did not win the exhibited item of merchandise in the action (col. 23, lines 19-29).

As to claim 16, Rackson discloses the method of claim 15, wherein said selecting step comprises:

extracting preference information based on the bid information and exhibited merchandise information bid on by the unsuccessful participant (col. 14, lines 7-49); and selecting the alternative merchandise information from the plurality of merchandise information based on the preference information (col. 23, lines 18-29).

As to claim 19, Rackson discloses a computer program product comprising a computer storage medium having a computer program code mechanism embedded in the computer storage medium configured to perform the steps recited in any one of claims 13-18 (col. 9, lines 7-56).

As to claim 20, Rackson discloses an auction system comprising:  
a plurality of terminals offering bids for exhibited merchandise information concerning an exhibited item of merchandise exhibited in an electronic auction (col. 8, lines 49-67 and col. 9, lines 1-49);



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a server computer connected to the plurality of terminals through a network and configured to hold the auction, said server including, a providing module providing the exhibited merchandise information to the terminals, a receiving module receiving bid information, which includes information indicating a bidder from the terminals and storing the bid information (col. 8, lines 49-67 and col. 9, lines 1-49);

a merchandise database storing a plurality of merchandise information (col. 9, lines 1-49);

means for selecting alternative merchandise information from the merchandise database based on stored information for an unsuccessful bidder who did not win the exhibited item of merchandise in the auction, the alternative merchandise information being information concerning an unexhibited item of merchandise not exhibited in the auction (col. 23, lines 18-29); and

means for causing to notify a terminal associated with the unsuccessful bidder of the alternative selected merchandise information concerning the unexhibited merchandise (col. 23, lines 18-29).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7, 9, 11, 12, 18 and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rackson, in view of Chen et al. (herein Chen), US Pat. No. 6,741,969

B1.

As to claim 7, Rackson discloses a server computer (col. 8, lines 6-17 and 49-63) for electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said server computer connected through a network to a plurality of terminals each associated with a bidder in the auction for the exhibited item of merchandise (col. 8, lines 49-63), said server computer comprising:

means for extracting preference information based on bid information stored for an unsuccessful bidder who did not win the exhibited item of merchandise in the auction and exhibited merchandise information concerning the exhibited item of merchandise bid on by the unsuccessful bidder (col. 14, lines 7-49).

Rackson does not explicitly disclose the means for causing a communication unit to transmit the preference information to an exhibitor configured to select the alternative

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merchandise information for the unsuccessful bidder based on the preference information, the alternative merchandise exhibited in the auction.

However, Chen teaches that a processing system can be used to notify a losing bidder of other auctions that have one or more parameters of the auction that the losing bidder unsuccessfully bid (col. 11, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the aforementioned limitations as disclosed by Chen within Rackson for the motivation of notifying losing bidders of other auctions where alternatives merchandise can be found.

As to claim 9, Rackson discloses a server computer (col. 8, lines 6-17 and 49-63) for electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said server computer connected through a network to a plurality of terminals each associated with a bidder in the auction for the exhibited item of merchandise (col. 8, lines 49-63), said server computer comprising:

a storage unit configured to store bid information (col. 9, lines 1-49);

means for extracting preference information based on the bid information stored for an unsuccessful bidder in the auction for the exhibited item of merchandise and information concerning the exhibited item of merchandise bid on by the bidder, the unsuccessful bidder being a bidder in the auction who did not win the exhibited item (col. 14, lines 7-49);

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means for associating the preference information and the bid information and for storing the associated preference and bid information (col. 14, lines 30-49 and col. 9 lines 1-49); and

means for causing to notify a terminal associated with the unsuccessful bidder of the alternative merchandise information concerning the unexhibited item of merchandise based on the associated preference and bid information (col. 23, lines 19-29).

Rackson does not explicitly disclose the means for receiving the alternative merchandise information selected by an exhibitor, the alternative merchandise information being information concerning an unexhibited item of merchandise that was not exhibited in the auction.

However, Chen teaches that a processing system can be used to notify a losing bidder of other auctions that have one or more parameters of the auction that the losing bidder unsuccessfully bid (col. 11, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the aforementioned limitations as disclosed by Chen within Rackson for the motivation of notifying losing bidders of other auctions where alternatives merchandise can be found.

As to claim 11, Rackson discloses a server computer (col. 8, lines 6-17 and 49-63) for electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said server computer connected through a network to a plurality of terminals each associated with a

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bidder in the auction for the exhibited item of merchandise (col. 8, lines 49-63), said server computer comprising:

means for extracting preference information based on bid information stored for an unsuccessful bidder in the auction for the exhibited item of merchandise in the auction and exhibited merchandise information concerning, the exhibited item of merchandise bid on by the unsuccessful bidder (col. 14, lines 7-49); and

means for causing to notify a terminal associated with the unsuccessful bidder of the alternative merchandise information concerning the unexhibited item of merchandise (col. 23, lines 19-29).

Rackson does not explicitly disclose the means for causing a communication unit to transmit the preference information to an exhibitor; and means for receiving the alternative merchandise information for the unsuccessful bidder selected by the exhibitor based on the preference information, the alternative merchandise information being information concerning an unexhibited item of merchandise that was not exhibited in the auction.

However, Chen teaches that a processing system can be used to notify a losing bidder of other auctions that have one or more parameters of the auction that the losing bidder unsuccessfully bid (col. 11, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the aforementioned limitations as disclosed by Chen within Rackson for the motivation of notifying losing bidders of other auctions where alternatives merchandise can be found.

As to claim 12, Rackson discloses a server computer (col. 8, lines 6-17 and 49-63) for electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said server computer connected through a network to a plurality of terminals each associated with a bidder in the auction for the exhibited item of merchandise (col. 8, lines 49-63), said server computer comprising:

means for holding the auction electronically, said auction holding means, comprising, means for providing exhibited merchandise information for the auction to the terminals, and means for receiving bid information, which includes information indicating a bidder, from the terminals and for storing the bid information (col. 8, lines 49-67 and col. 9, lines 1-49);

means for extracting preference information based on bid information stored for an unsuccessful bidder in the auction for the exhibited item of merchandise and exhibited merchandise information concerning the exhibited item of merchandise bid on by the unsuccessful bidder being a bidder who did not win the exhibited item in the auction (col. 14, lines 7-49); and

means for receiving the alternative merchandise information selected by the exhibitor, the alternative merchandise information concerning an unexhibited item of merchandise that was not exhibited in the auction (col. 23, lines 19-29).

Rackson does not explicitly disclose the means for causing a communication unit to transmit the preference information to an exhibitor; and means for causing to notify a terminal associated with the unsuccessful bidder of the alternative merchandise

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information concerning the unexhibited item of merchandise and based on the preference information stored for the unsuccessful bidder.

However, Chen teaches that a processing system can be used to notify a losing bidder of other auctions that have one or more parameters of the auction that the losing bidder unsuccessfully bid (col. 11, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the aforementioned limitations as disclosed by Chen within Rackson for the motivation of notifying losing bidders of other auctions where alternatives merchandise can be found.

As to claim 18, Rackson discloses a method (col. 8, lines 6-17 and 49-63) of electronically introducing alternative merchandise information after closing an electrical auction for an exhibited item of merchandise (col. 23, lines 18-29), said method comprising:

storing bid information (col. 9, lines 1-49);

extracting preference information based on bid information stored for an unsuccessful bidder and exhibited merchandise information bid on by the unsuccessful bidder, the unsuccessful bidder being a bidder in the auction who did not win the exhibited item of merchandise (col. 14, lines 7-49);

associating the preference information and the bid information and storing the

associated preference and bid information (col. 14, lines 30-49 and col. 9 lines 1-49);

and

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causing to notify a terminal associated with the unsuccessful bidder of the alternative merchandise information concerning the unexhibited item of merchandise based on the associated preference and bid information (col. 23, lines 19-29).

Rackson does not explicitly disclose receiving the alternative merchandise information selected by an exhibitor, the alternative merchandise information being information concerning an unexhibited item of merchandise not exhibited in the auction.

However, Chen teaches that a processing system can be used to notify a losing bidder of other auctions that have one or more parameters of the auction that the losing bidder unsuccessfully bid (col. 11, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the aforementioned limitations as disclosed by Chen within Rackson for the motivation of notifying losing bidders of other auctions where alternatives merchandise can be found.

As to claim 21, Rackson discloses an auction system comprising:  
a plurality of terminals offering a bid on exhibited merchandise information concerning an exhibited item of merchandise exhibited in an electronic auction (col. 8, lines 49-67 and col. 9, lines 1-49);  
a terminal of an exhibitor of the exhibited item (col. 9, lines 50-56);  
a server computer, connected to the plurality of terminals and the terminal of the exhibitor through a network and configured to hold the auction, said server including, means for providing exhibited merchandise information for the auction to the terminals, and means for receiving bid information, which includes information indicating a bidder



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from the terminals and for storing the bid information, means for extracting preference information based on the stored bid information of an unsuccessful bidder who did not win the exhibited item in the auction and the exhibited merchandise information bid on by the unsuccessful bidder (col. 14, lines 7-49; col. 8, lines 49-67; col. 9, lines 1-49; and col. 23, lines 18-29); and

means for causing to notify the unsuccessful bidder of the alternative merchandise information concerning the unexhibited item of merchandise (col. 23, lines 19-29).

Rackson does not explicitly disclose the means for causing a communication unit to transmit preference information to the exhibitor; and means for receiving alternative merchandise information selected by exhibitor, the alternative merchandise information being information concerning an unexhibited item of merchandise not exhibited in the auction.

However, Chen teaches that a processing system can be used to notify a losing bidder of other auctions that have one or more parameters of the auction that the losing bidder unsuccessfully bid (col. 11, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the aforementioned limitations as disclosed by Chen within Rackson for the motivation of notifying losing bidders of other auctions where alternatives merchandise can be found.

### ***Conclusion***

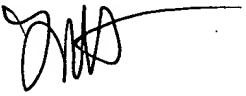
Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is

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(571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LALITA M. HAMILTON  
PRIMARY EXAMINER

GREGORY JOHNSON  
Examiner  
Art Unit 3691

